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09/776,188	02/03/2001	Kelly L. Zimmerman		1487

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EXAMINER

NGUYEN, CUONG H

ART UNIT	PAPER NUMBER
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3661

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/776,188

Applicant(s)

ZIMMERMAN ET AL. *ST*

Examiner

CUONG H. NGUYEN

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/16/2004 (the RCE).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Status of the claims

1. Claims 1-17 are pending; claims 18-20 are added on 8/16/2004 (the submitted RCE).

Priority

2. This application is a CIP of prior Application No. 09/455,145, filed 12/06/1999, and claims the benefit of U.S. Provisional Application # 60/182,624, filed 2/15/2000.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 11, and 20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "communicating a diagnostic message from a vehicle, comprising: detecting the diagnostic message", does not reasonably provide enablement for automatically ... communicating the diagnostic message independent of a command from a service diagnostic tool. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to duplicate the invention commensurate in scope with these claims.

Art Unit: 3625

A. For claim 1: that is "automatically ... communicating the diagnostic message independent of a command from a service diagnostic tool", the examiner believes that a response should be dependent from a command; therefore, the above limitation normally and reasonably does not happen.

B. For claim 11: that is "wirelessly communicating the diagnostic message independent of a command from a service diagnostic tool obtaining the diagnostic message", the examiner believes that a response should be dependent from a command; therefore, the above limitation normally and reasonably does not happen.

C. For claim 20: that is "automatically ... communicating the diagnostic message to a manufacturer of the vehicle independent of a command from a service diagnostic tool for obtaining the diagnostic message" ", the examiner believes that a response should be dependent from a command; therefore, the above limitation normally and reasonably does not happen.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

Art Unit: 3625

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 4-11, 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Arjomand (US Pat. 5,884,202).

A. As to claim 11: As best understood, Arjomand sufficiently teaches a method of communicating a diagnostic message from a vehicle, comprising:

- detecting the diagnostic message (see **Arjomand**, Fig.1, ref. 16, and 1:5-30);
- requesting to initiate a wireless communication in response to the diagnostic message (see **Arjomand**, Fig.1, ref. 16, 3:22-46; and Fig.8, ref. 14); and
- communicating to obtain a diagnostic message (see **Arjomand**, the abstract, Fig.3, and Fig.8, ref. 50).

- Therefore, Arjomand teaches all claimed limitations.

B. As to claim 1: As best understood, it comprises similar limitations as claim 11; therefore, similar rationales and reference set forth are applied for a 35 USC 102(b) rejection.

C. As to claim 14: As best understood, Arjomand teaches a method of communicating a diagnostic message from a vehicle, further comprising communicating with an occupant of the vehicle to schedule an appointment for service (see **Arjomand**, the

Art Unit: 3625

abstract, Fig.6, ref. 12, and 1:5-30, 1:30-37). In summary, Arjomand teaches that communication step before bringing a vehicle for services.

D. As to claims 5, 16: As best understood, these claims comprise similar limitations as claim 14; therefore, similar rationales and reference set forth are applied for 35 USC 103(a) rejections.

E. As to claim 15: As best understood, Arjomand teaches a method of communicating a diagnostic message from a vehicle (see **Arjomand**, the abstract, and Fig.6).

Arjomand also teaches about commanding a wireless communication representing a diagnostic message from an electrical management system (see **Arjomand**, the abstract, Fig.8, ref. 16, and 1:5-30, 1:30-37). In another word, Arjomand teaches that claimed communication step using a user interface module (ref.12) and a VOM (ref.16).

F. As to claim 4: As best understood, it comprises similar limitations as claim 15; therefore, similar rationale and reference set forth are applied for a 35 USC 102(b) rejection.

G. As to claim 17: As best understood, Arjomand teaches a method of communicating a diagnostic message from a vehicle, wherein initiating a wireless communication comprises commanding a device to transmit a wireless communication through a user

Art Unit: 3625

interface module, and a main control module to i.e., "control and obtain data by wireless communication", "executes diagnostic application programs and displays information to the user" (see **Arjomand**, the abstract, Figs.6, 8, and 1:5-37).

H. As to claims 6-10: As best understood, these claims comprise similar limitations as claim 17; therefore, similar rationales and references set forth are applied for 35 USC 102(b) rejections.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arjomand (US Pat. 5,884,202) as applied to claim 1 above, and further in view of Razavi et al. (US Pat. 6,362,730).

As best understood, Arjomand teaches a method of communicating a diagnostic message from a vehicle (see Arjomand, the abstract, and Fig.6).

Arjomand does not disclose that wirelessly communication a message representing the vehicle's location.

However, Razavi et al. suggest that feature (see Razavi et al., the abstract).

It would have been obvious to one of ordinary skill in the art to combine Arjomand with Razavi et al. in adding information about a vehicle's location in a communication message because artisan recognized that this extra information is clearly necessary in certain case (e.g., for towing a disable vehicle).

6. Claims 12, 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arjomand (US Pat. 5,884,202) as applied to claim 11 above, in view of the Official Notice.

As best understood, Arjomand teaches a method of communicating a diagnostic message from a vehicle (see **Arjomand**, the abstract, and Fig.6).

A. As per new claim 18: It merely defines a message for an emergency condition, it is obvious to Arjomand that what contains in a message could be anything and considered as non-functional descriptive material; the specific contain of a message do not make the claim becomes inventive because it doesn't contribute to a different step of communicate a message.

B. As per new claim 19: It is directed to a step of determining an emergency condition based on received signals. It would be

Art Unit: 3625

obvious with Arjomand to understand the received information (by interpreting received messages); e.g., an emergency condition from accelerometer/engine's information.

C. As per new claim 12:

Arjomand does not expressly disclose an occupant of the vehicle initiates a wireless communication.

However, the Official Notice is taken here that it is old and well-known for an occupant of the vehicle to initiate a communication (e.g., if a cell-phone received a voice-mail message, a user to initiate an action of listening to that voice-mail by pressing a button; the act of initiating a communication was known by the meaning of that word itself to be initiated).

It would have been obvious with one of ordinary skill in the art at the time of invention to implement the above Official Notice in Arjomand's patent because it is efficient to initiating a communication whenever there is a need because this act only requires to press a button. It also saves active energy by de-activating/putting in a sleep-mode.

7. Claims 3, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arjomand (US Pat. 5,884,202) as applied to claim 11 above, in view of Phillips et al. (US Pat. 6,351,221).

A. As to claim 13: As best understood, Arjomand teaches a method of communicating a diagnostic message from a vehicle.

Arjomand does not disclose about notifying that a diagnostic message has been communicated.

However, Phillips et al. teach about that limitation (see **Phillips** et al., 1:28-55).

It would have been obvious with one of ordinary skill in the art to combine Arjomand and Phillips et al., because they are in the same field of endeavor, and a motivation of Phillips et al. about notifying a communication is already established would ensure that a diagnostic message is being transmitted and is received successfully.

B. As to claim 3: As best understood, it comprises similar limitations as claim 13; therefore, similar rationale and reference set forth are applied for a 35 USC 103(a) rejection.

8. Remark: Please note that the meanings of scope in pending claims (RCE) are considered similar to original version although they are amended with "different claimed language"; therefore, similar rationales and references are applied.

Furthermore, claims directed to an apparatus/configuration must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a "recitation with

respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claimed system do not distinguish Arjomand and Razavi et al.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 703-305-4553. The examiner can normally be reached on 7 am - 330 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, JEFFREY A. SMITH can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

Cuonghnguyen

CHN
CUONG H. NGUYEN
Primary Examiner
Art Unit 3625